

ESTTA Tracking number: **ESTTA186905**

Filing date: **01/16/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181360
Party	Defendant Weld, Greg
Correspondence Address	MICHAEL A. WILLIAMSON POL SINELLI SHALTON WELTE SUELTHAUS PC 700 W 47TH ST STE 1000 KANSAS CITY, MO 64112-1805 uspt@pswslaw.com
Submission	Other Motions/Papers
Filer's Name	Michael A Williamson
Filer's e-mail	uspt@polsinelli.com, mwilliamson@polsinelli.com
Signature	/Michael A. Williamson/
Date	01/16/2008
Attachments	Motion To Suspend.pdf (3 pages)(47996 bytes) Exhibit A.pdf (26 pages)(730843 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN RACING EQUIPMENT,)	
INC.,)	
)	
Opposer,)	
)	Opposition No.: 91181360
v.)	
)	
GREG WELD,)	
)	
Applicant.)	
)	

MOTION TO SUSPEND

Defendant hereby moves, pursuant to Trademark Rule 37 CFR §2.117, that all further proceeding in this opposition, including a response to the Notice of Opposition, be suspended pending disposition of Civil Action No. 07-0774-CV-W-JTM, entitled American Racing Equipment, Inc. v. Richard G Weld and Greg Weld, Inc., which is pending in the United States District Court for the Western District of Missouri. This civil action includes claims for trademark infringement and unfair competition under the Lanham Act and seeks, inter alia, to enjoin applicant's further use of the trademark TEAM WELD, the mark in issue in this opposition. A copy of the complaint filed in this civil action is attached as Exhibit A. Disposition of the civil action will determine whether applicant is entitled to use and register the trademark TEAM WELD and therefore is potentially dispositive of this opposition.

Accordingly, defendant requests that this opposition be suspended pending disposition of civil Action No. 07-0774-CV-W-JTM.

Respectfully submitted,

POLSINELLI SHALTON FLANIGAN SUELTHAUS PC

Dated: January 16, 2008

By:

A handwritten signature in black ink, appearing to read "Michael A. Williamson", written over a horizontal line.

Michael A. Williamson Reg. No. 54,541
700 West 47th Street, Suite 1000
Kansas City, Missouri 64112
(816) 753-1000
Fax No. (816) 753-1536

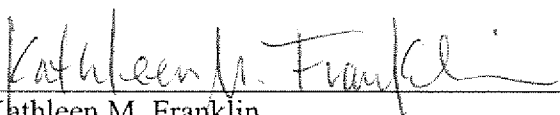
ATTORNEYS FOR APPLICANT
GREG WELD

CERTIFICATE OF SERVICE

This is to certify that I have this day served the foregoing Motion to Suspend and Exhibit A upon Opposer, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Opposer's counsel of record as follows:

Rochelle D. Alpert
Morgan, Lewis & Bockius LLP
One MarketSpear Tower
San Francisco, CA 94105

This 16th day of January, 2008.



Kathleen M. Franklin

Exhibit A

UNITED STATES DISTRICT COURT
Western District of Missouri

AMERICAN RACING EQUIPMENT, INC.

SUMMONS IN A CIVIL CASE

V.

RICHARD G. WELD and GREG WELD, INC.

CASE NUMBER: 07-0774-CV-W-JTM

TO: (Name and address of Defendant)

Greg Weld, Inc.

Registered Agent: PWS Agent Services, Inc.

700 West 47th Street, Suite 1000

Kansas City, MO 64112

YOU ARE HEREBY SUMMONED and required to serve on PLAINTIFF'S ATTORNEY (name and address)

Jeffrey H. Kass, Armstrong Teasdale, LLP

One Metropolitan Square, Suite 2600

St. Louis, MO 63102

an answer to the complaint which is served on you with this summons, within 20 days after service of this summons on you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. Any answer that you serve on the parties to this action must be filed with the Clerk of this Court within a reasonable period of time after service.

Patricia L. Bunn

CLERK

Joella Buel

OCT 22 2007

DATE

(By) DEPUTY CLERK

AO 440 (Rev. 8/01) Summons in a Civil Action

RETURN OF SERVICE		
Service of the Summons and complaint was made by me ⁽¹⁾	DATE	
NAME OF SERVICE (PRINT)	TITLE	
<i>Check one box below to indicate appropriate method of service</i>		
<input type="checkbox"/> Served personally upon the defendant. Place where _____ _____		
<input type="checkbox"/> Left copies thereof at the defendant's dwelling house or usual place of abode with a person of suitable age and discretion then residing therein. Name of person with whom the summons and complaint were _____ _____		
<input type="checkbox"/> Returned _____ _____ _____		
<input type="checkbox"/> Other (specify): _____ _____ _____		
STATEMENT OF SERVICE FEES		
TRAVEL	SERVICES	TOTAL
DECLARATION OF SERVER		
I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Return of Service and Statement of Service Fees is true and correct.		
Executed on _____ <div style="display: flex; justify-content: space-around;"> Date Signature of Server </div> <div style="text-align: center;"> _____ Address of Server </div>		

(1) As to who may serve a summons see Rule 4 of the Federal Rules of Civil Procedure.

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
WESTERN DIVISION**

AMERICAN RACING EQUIPMENT, INC.,)	
)	
Plaintiff,)	
)	
vs.)	CASE NO.
)	
RICHARD G. WELD and GREG WELD,)	JURY TRIAL DEMANDED
INC.,)	
)	
Defendants.)	

COMPLAINT

Plaintiff American Racing Equipment, Inc. ("American Racing") hereby submits its Complaint for monetary damages and injunctive relief against Defendants Richard G. Weld (also known as Greg Weld) and Greg Weld, Inc. All counts are directed to both defendants.

Introduction

1. This action involves the willful infringement of trademarks and trade names, as well as false advertising and other related wrongful conduct.
2. Over a period of approximately 30 years, Weld Racing and other Weld Companies (as hereinafter defined) were well-known suppliers of automotive wheels and related parts and accessories. Weld Racing was the owner of numerous well-known trademarks and trade names, including but not limited to, WELD, WELD RACING and WELDWHEELS, all of which were widely recognized as distinctive identifiers of the Weld Companies' products.
3. On September 28, 2006, Defendant Richard G. "Greg" Weld, one of the owners of the Weld Companies, through a bankruptcy proceeding, sold substantially all of the assets of certain Weld Companies, including all trademarks and trade names used by the companies, to American Racing for over \$20 million. Despite that sale and the express terms of the governing

agreement, Greg Weld immediately established and incorporated a competing business under the confusingly similar “Team Weld” name. He later changed the name to Greg Weld, Inc. Greg Weld also began using the confusingly similar names and marks GREG WELD, TEAM WELD and WELD in connection with his “new” and directly competitive business. Since that time, and despite American Racing’s demands that he stop, Greg Weld and his companies have been conducting business under trademarks and trade names that are identical and/or confusingly similar to the ones his companies sold to American Racing. In fact, unbeknownst to American Racing, Greg Weld began using the trademark GREG WELD a month before the sale of certain of the Weld Companies’ assets to American Racing. Greg Weld and his companies also have engaged in false and misleading advertising by claiming that their products are the “Genuine” WELD wheels and implying that American Racing’s WELD wheels are not genuine.

4. The defendants’ actions constitute, among other things, willful trademark infringement and false advertising.

Parties

5. Plaintiff American Racing Equipment, Inc. is a Delaware corporation with its principal place of business in California.

6. Defendant Greg Weld is a Missouri citizen residing in Lee’s Summit, Missouri.

7. Defendant Greg Weld, Inc. is a Missouri Corporation with a principal place of business in Kansas City, Missouri. Its registered agent is PWS Agent Services, Inc. in Kansas City, Missouri. Greg Weld is the controlling member and President of Greg Weld, Inc. Except where the context indicates otherwise, and except in the prayers for relief, the name “Greg Weld” as used in this Complaint, shall refer to Greg Weld as an individual and Greg Weld, Inc. together.

Jurisdiction

8. American Racing asserts claims for trademark infringement, unfair competition and false advertising under Sections 32 and 43(a) of the Lanham Act. This Court, therefore, has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1336. This Court has subject matter jurisdiction over the related state common law and statutory claims raised in this action pursuant to 28 U.S.C. §§ 1367 and 1338(b).

9. This Court has personal jurisdiction over the defendants. Greg Weld, the individual, resides in this District, and Greg Weld, Inc. is a Missouri corporation with a principal place of business in this District. Greg Weld promotes and offer for sale products in this District under trade names and trademarks that infringe American Racing's trade names and trademarks. Further, Greg Weld's acts constitute the commission of a tort within the State of Missouri that impacts or affects residents of the State of Missouri.

10. Venue is proper in this District under 28 U.S.C. § 1391 because the defendants are citizens of Missouri and reside in this District, and a substantial part of the events giving rise to these claims occurred and continues to occur in this District.

Factual Allegations Common To All Counts

11. Upon information and belief, Greg Weld, the individual, was one of the owners of several companies in the business of supplying, manufacturing, and/or distributing automotive wheels and parts and related accessories, including, but not limited to, the companies known as Weld Wheel Industries, Inc., Weld Racing, Inc. and Weld Distribution, Inc. The "Weld Companies" shall refer to these three entities and all predecessor and/or related companies.

12. The Weld Companies were incorporated as early as 1969, continuing through the 1970's and 1980's.

13. From 1969 to 2006, the Weld Companies grew to become well-known providers

of automotive wheels and parts and related accessories. As a result, the trade names and trademarks associated with those companies, such as the WELD, GREG WELD, WELD RACING AND WELDWHEELS marks and names and many others, became widely recognized and famous throughout the United States, including in Missouri, as identifiers of source for the Weld Companies and their products and services, including their wheels.

14. On August 17, 2006, certain of the Weld Companies filed for bankruptcy and ultimately sold their assets including all intellectual property associated with those companies and their business to American Racing.

15. On September 28, 2006, American Racing and certain Weld Companies entered into an Amended and Restated Asset Purchase Agreement (the “Agreement”), which transferred all intellectual property of those Weld Companies, including all trade names, trademarks, domain names and patents, to American Racing in exchange for more than \$20 million in cash and other consideration.

16. In addition to the express terms of the Agreement unequivocally transferring all of certain Weld Companies’ intellectual property to American Racing, Section 2.1 and Schedule 4.2.1 of the Agreement also listed and included specific representations concerning the intellectual property owned and being transferred by those Weld Companies to American Racing. These representations referenced the “trademarks, service marks, trade dress, logos, slogans, trade names, corporate names, Internet domain names....” By virtue of the plain language of the Agreement and operation of law, the Weld Companies transferred, along with other unregistered marks and names, the following federally registered and applied for trademarks, along with the goodwill associated therewith, to American Racing:

TABLE OF REGISTERED WELD TRADEMARKS AND APPLICATIONS
(referred to as the "Registered WELD Marks")

Registered Marks	Registration No.	Registration Date	Date Of First Use	Owner
WELD EVO	2226933	3/2/1999	2/9/1994	American Racing Equipment
WELD RACING	2000079	9/10/1996	12/31/1983	American Racing Equipment
WELD RACING	2003222	9/24/1996	12/31/1983	American Racing Equipment
WELD RACING	2008430	10/15/1996	12/31/1983	American Racing Equipment
WELDWHEELS	2086419	8/5/1997	6/1/1996	American Racing Equipment
WELDWHEELS	2166255	6/16/1998	9/30/1997	American Racing Equipment

17. The Agreement also effectuated a transfer to American Racing of over 30 domain names used or intended to be used as identifiers of source for the Weld Companies and their products and services, including, but not limited to, "weldracing.com," "weldmotorsports.com," "weldevo.com" and "weldamerica.com."

18. As a result of the Agreement's plain language transferring all of certain Weld Companies' intellectual property to American Racing, those Weld Companies also transferred to American Racing the exclusive right to use WELD and GREG WELD as trademarks and trade names, domain names and any other source identifier in connection with automotive parts and equipment, as well as clothing and other products and services. "WELD Marks" used herein shall refer to all of American Racing's registered and unregistered names, marks and domain names which incorporate "WELD."

19. Since its acquisition of the Weld Companies and all of their intellectual property, American Racing has used in connection with its business the WELD Marks, including, but not limited to, WELD RACING, WELD EVO, WELD WHEELS, WELD DISTRIBUTION, and other WELD trademarks and trade names, and it has maintained registrations to do business throughout the United States, including Missouri.

20. On October 18, 2006, unbeknownst to American Racing, Greg Weld incorporated

Team Weld, Inc. as a Missouri corporation and began conducting business under trade names, and using trademarks, that are confusingly similar to the marks and names Greg Weld sold to American Racing, such as GREG WELD and TEAM WELD marks and names. On October 27, 2006, Greg Weld changed his company name from Team Weld, Inc. to Greg Weld, Inc.

21. In addition, Greg Weld, as an individual, filed federal trademark applications for GREG WELD, Ser. No. 77-210399, and TEAM WELD, Ser. No. 77-024370. These applications remain pending in the U.S. Patent and Trademark Office.

22. On December 11, 2006, American Racing, through its counsel, sent a letter to Greg Weld demanding, among other things, that Greg Weld cease all use of and abandon any plans to use any mark or name that is comprised of or incorporates the WELD mark.

23. Greg Weld refused to comply with American Racing's demand to cease using the infringing names and marks.

24. In fact, since American Racing's acquisition of the assets of certain Weld Companies, Greg Weld has engaged in a myriad of unlawful acts intended to cause marketplace confusion with, and to trade on the good will and reputation of, the WELD Marks that American Racing acquired for more than \$20 million, and to otherwise interfere with and harm American Racing's business.

25. Greg Weld used and, on information belief, continues to use, the confusingly similar GREG WELD, GREG WELD, INC., GREG WELD MOTORSPORTS, GREG WELD FORGED WHEELS and TEAM WELD marks and names and the confusingly similar domain names gregweld.com and gregweldinc.com (collectively the "Infringing Marks"), to compete directly with American Racing's business. American Racing is informed and believes, and on that basis alleges, that Greg Weld's infringing acts include, but are not limited to:

- a) using one or more Infringing Marks on automotive wheels and clothing;
- b) using the Infringing Marks to promote and sell competitive wheels;
- c) participating in industry events under confusingly similar names, marks and designations;
- d) registering and using confusingly similar domain names, including “gregweld.com” and “gregweldinc.com” to promote and sell competitive wheels;
- e) using and/or taking actions to use American Racing’s trademarks, including WELD WHEELS, WELD RACING and AMERICAN RACING, as metatags for a web site to be located at the confusingly similar “gregweld.com” web site and on other web sites; and
- (f) falsely representing that GREG WELD and TEAM WELD are registered trademarks, while they are not.

26. Greg Weld’s infringing activities have caused multiple instances of actual confusion among consumers, and such activities certainly will cause more confusion.

27. On at least two occasions in the fall of 2007, Federal Express even confused American Racing’s WELD Marks with Greg Weld’s Infringing Marks and sent materials intended for Greg Weld’s new “Weld” companies to American Racing.

COUNT I

Trademark Infringement Under Section 32 of the Lanham Act, 15 U.S.C. § 1114—Infringement of Registered WELD Marks

28. American Racing restates paragraphs 1 through 27 as if fully set forth herein.

29. Greg Weld’s unauthorized use of the Infringing Marks is likely to cause confusion among consumers as to the source of Greg Weld’s products, and cause the mistaken belief that

Greg Weld's products and/or commercial activities are affiliated with or sponsored or approved by American Racing, or that Greg Weld's and American Racing's products originate from the same source.

30. Greg Weld's use of the Infringing Marks, therefore, infringes American Racing's trademark rights in the Registered WELD Marks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114(1), resulting in damages to American Racing.

31. Greg Weld's wrongful use of the Infringing Marks is a deliberate, intentional, and willful attempt to injure American Racing's business, to trade on its business reputation, to palm off or pass off Greg Weld's products as coming from American Racing, and/or to confuse and deceive consumers.

32. Greg Weld's acts are greatly and irreparably damaging American Racing and will continue to damage American Racing unless enjoined by this Court.

33. Greg Weld and Greg Weld, Inc. have been, and are likely to continue to be, unjustly enriched by their infringing conduct.

34. Because of Greg Weld's wrongful conduct, this is an "exceptional case" under the Lanham Act. 15 U.S.C. § 1117(a).

WHEREFORE, American Racing requests that judgment be entered in its favor and that:

A. This Court award all damages and other monetary relief available as a result of Defendants Greg Weld and Greg Weld, Inc.'s wrongful conduct, such damages and monetary relief including, but not limited to, actual damages, lost profits, the defendants' profits, treble damages, attorneys' fees, and all other monetary relief available under 15 U.S.C. § 1117;

B. This Court enter injunctive relief ordering Greg Weld, the individual, and Greg Weld, Inc., and their successors, assigns, affiliates, employees, partners, and anyone acting in

concert with them or at their behest or direction, to:

- (1) Cease all use of trade name and/or trademark GREG WELD, GREG WELD, INC., GREG WELD MOTORSPORTS, TEAM WELD, gregweld.com, gregweldinc.com and any other trademark, logo, designation, domain name or other source identifier that contains WELD or is otherwise confusingly similar to any of the Registered WELD Marks;
- (2) Refrain from doing any other act or thing likely to induce the belief that any Greg Weld and/or Greg Weld, Inc.'s business, products, services or commercial activities are in any way legitimately connected with or sponsored or approved by American Racing;
- (3) Deliver up for destruction all goods, labels, signs, brochures, prints, promotional materials, advertisements, packaging, manuals, wheel inscriptions, and any and all other material of an infringing or unfair or deceptive nature in Greg Weld's or Greg Weld, Inc.'s, as well as all plates and other means of making the same;
- (4) Disable all websites or email accounts owned, operated or controlled by Greg Weld, Greg Weld, Inc., or any of their affiliates, partners or employees that contain the Infringing Marks and any other confusingly similar marks;
- (5) Remove from any website or other online marketing or promotional materials all references to the GREG WELD, GREG WELD, INC., GREG WELD or TEAM WELD marks and names, or the "gregweld.com" domain name, or any other trademark, trade name, logo, domain name,

designation, or other source identifier that contains WELD or is otherwise confusingly similar to the Registered Weld Marks;

- (6) Dissolve or rename, in accordance with subparagraphs (1) and (2) above, Greg Weld, Inc.;
- (7) Pursuant to certain controls, take corrective action by notifying all current and prior customers of American Racing that Greg Weld and Greg Weld, Inc. are not in any way affiliated with American Racing;
- (8) Remove all metatags for any web site owned, operated or controlled by Greg Weld, Greg Weld, Inc., or its affiliates, partners or employees that incorporate the WELD mark, the AMERICAN RACING mark, and/or any other marks or names owned or used by American Racing;
- (9) Expressly abandon all trademark applications incorporating WELD; and
- (10) Cease filing trademark applications for any mark or name incorporating WELD or anything confusingly similar thereto.

C. This Court award American Racing such other and further relief, including costs, as this Court deems just and equitable.

COUNT II

Unfair Competition Under Section 43(a) Of The Lanham Act, 15 U.S.C. § 1125(a)

35. American Racing restates paragraphs I through 27 as if fully set forth herein.

36. Greg Weld's use of the Infringing Marks is likely to cause confusion among consumers as to the source of Greg Weld's products, and cause the mistaken belief that Greg Weld's business, products and/or commercial activities are affiliated with or sponsored or approved by American Racing, or that American Racing's and Greg Weld's products originate from the same source.

37. Greg Weld's use of the Infringing Marks infringes American Racing's trademark rights in the Weld Marks in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), resulting in damages to American Racing.

38. Greg Weld's wrongful use of the Infringing Marks is a deliberate, intentional and willful attempt to injure American Racing's business, to trade on American Racing's business reputation, to palm off or pass off Greg Weld's products as coming from American Racing, and/or to confuse and deceive consumers.

39. Greg Weld's acts are greatly and irreparably damaging American Racing and will continue to damage American Racing unless enjoined by this Court.

40. Greg Weld and Greg Weld, Inc. have been, and are likely to continue to be, unjustly enriched by their infringing conduct.

41. Because of Greg Weld's wrongful conduct, this is an "exceptional case" under the Lanham Act.

WHEREFORE, American Racing requests that judgment be entered in its favor and that:

A. The Court award American Racing all damages and other monetary relief available as a result of Greg Weld's and Greg Weld, Inc.'s wrongful conduct, such damages and monetary relief including, but not limited to, actual damages, statutory damages, lost profits, the defendants' profits, treble damages and attorneys' fees as provided under the Lanham Act;

B. This Court enter injunctive relief ordering Greg Weld, the individual, and Greg Weld, Inc., and their successors, assigns, affiliates, employees, partners, and anyone acting in concert with them or at their behest or direction, to:

- (1) Cease all use of trade name and/or trademark GREG WELD, GREG WELD, INC., GREG WELD MOTORSPORTS, TEAM WELD,

gregweld.com, gregweldinc.com and any other trademark, logo, designation, domain name or other source identifier that contains WELD or is otherwise confusingly similar to any of the Registered WELD Marks;

- (2) Refrain from doing any other act or thing likely to induce the belief that any Greg Weld and/or Greg Weld, Inc.'s business, products, services or commercial activities are in any way legitimately connected with or sponsored or approved by American Racing;
- (3) Deliver up for destruction all goods, labels, signs, brochures, prints, promotional materials, advertisements, packaging, manuals, wheel inscriptions, and any and all other material of an infringing or unfair or deceptive nature in Greg Weld's or Greg Weld, Inc.'s possession or control, as well as all plates and other means of making the same;
- (4) Disable all websites or email accounts owned, operated or controlled by Greg Weld, Greg Weld, Inc., or any of their affiliates, partners or employees that contain the Infringing Marks and any confusingly similar marks;
- (5) Remove from any website or other online marketing or promotional materials all references to the GREG WELD, GREG WELD, INC. or TEAM WELD marks and names, or the "gregweld.com" domain name, or any other trademark, trade name, logo, domain name, designation, or other source identifier that contains WELD or is otherwise confusingly similar to the Registered Weld Marks;

- (6) Dissolve or rename, in accordance with subparagraphs (1) and (2) above, Greg Weld, Inc.;
- (7) Pursuant to certain controls, take corrective action by notifying all current and prior customers of American Racing that Greg Weld and Greg Weld, Inc. are not in any way affiliated with American Racing;
- (8) Remove all metatags for any web site owned, operated or controlled by Greg Weld, Greg Weld, Inc., or its affiliates, partners or employees that incorporate the WELD mark, the AMERICAN RACING mark, and/or any other marks or names owned or used by American Racing;
- (9) Expressly abandon all trademark applications incorporating WELD; and
- (10) Cease filing trademark applications for any marks or names incorporating WELD or that are otherwise confusingly similar thereto.

C. The Court award American Racing such other and further relief, including costs, as this Court deems just and equitable.

COUNT III

Common Law Trademark Infringement

42. American Racing restates paragraphs 1 through 27 as if fully set forth herein.

43. Greg Weld's use of the Infringing Marks is likely to cause confusion among consumers as to the source of Greg Weld's products and cause the mistaken belief that American Racing's and Greg Weld's businesses are affiliated, or that their products originate from the same source.

44. Greg Weld's use of the Infringing Marks, therefore, infringes American Racing's common law trademark rights in the Weld Marks, resulting in damages to American Racing.

45. Greg Weld's wrongful use of the Infringing Marks is a deliberate, intentional and

willful attempt to injure American Racing's business, to trade on its business reputation, to palm off or pass off Greg Weld's products as coming from American Racing, and/or to confuse and deceive consumers. Greg Weld and Greg Weld, Inc. have been and are likely to continue to be unjustly enriched by their infringing conduct.

46. Greg Weld's acts are greatly and irreparably damaging American Racing and will continue to damage American Racing unless enjoined by this Court.

WHEREFORE, American Racing requests that judgment be entered in its favor and that:

A. The Court award American Racing all damages and other monetary relief available as a result of Greg Weld's and Greg Weld, Inc.'s wrongful conduct, such damages and monetary relief including, but not limited to, actual damages, statutory damages, lost profits, Defendants' profits, treble damages and attorneys' fees as provided under the Lanham Act;

B. This Court enter injunctive relief ordering Greg Weld, the individual, and Greg Weld, Inc., and their successors, assigns, affiliates, employees, partners, and anyone acting in concert with them or at their behest or direction, to:

- (1) Cease all use of the GREG WELD, GREG WELD, INC., GREG WELD MOTORSPORTS and TEAM WELD marks and names, as well as the gregweld.com and gregweldin.com domain names, and any other trade name, trademark, logo, domain name, designation or design mark that contains WELD or is otherwise confusingly similar to the WELD Marks;
- (2) Refrain from doing any other act or thing likely to induce the belief that Greg Weld's and/or Greg Weld, Inc.'s business, products, services or commercial activities are in any way legitimately connected with or sponsored or approved by American Racing;

- (3) Deliver up for destruction all labels, signs, brochures, prints, promotional materials, advertisements, packaging, manuals, wheel inscriptions and any and all other material of an infringing or unfair or deceptive nature in Greg Weld's and/or Greg Weld, Inc.'s possession or control, as well as all plates and other means of making the same;
- (4) Disable all websites or email accounts owned, operated or controlled by Greg Weld, Greg Weld, Inc., or any of their affiliates, partners or employees that contain the Infringing Marks or any other confusingly similar marks;
- (5) Remove from any website or other online marketing or promotional materials all references to the GREG WELD, GREG WELD, INC. or TEAM WELD marks, or "gregweld.com" domain name, or any other trademark, trade name, logo, domain name, designation, or design mark that contains WELD or is otherwise confusingly similar thereto;
- (6) Dissolve or rename, in accordance with subparagraphs (1) and (2) above, Greg Weld, Inc.;
- (7) Pursuant to certain controls, take corrective action by notifying all current and prior customers that neither Greg Weld nor Greg Weld, Inc. is in any way affiliated with American Racing; and
- (8) Remove all metatags for any web site owned, operated or controlled by Greg Weld, Greg Weld, Inc., or its affiliates, partners or employees that incorporate the WELD mark, the AMERICAN RACING mark, and/or any other marks or names owned or used by American Racing.

C. The Court award American Racing such other and further relief, including costs, as this Court deems just and equitable.

COUNT IV

Violation of Mo. Rev. Stat. §§ 417.061, 417.066 Trademark Infringement – State

47. American Racing restates paragraphs 1 through 27 as if set forth herein.

48. Greg Weld's unauthorized use of the Infringing Marks is likely to cause confusion, mistake or deception as to the source, origin, sponsorship or approval of Greg Weld's products in that consumers and others are likely to believe American Racing authorizes or controls the sale of Greg Weld's products or that Greg Weld is associated with or related to American Racing. Greg Weld's unauthorized use is also likely to cause injury to American Racing's business reputation and to dilute the distinctive quality of the Weld Marks.

49. Greg Weld's use of the Infringing Marks infringes and dilutes the Weld Marks, entitling American Racing to injunctive relief pursuant to Mo. Rev. Stat. §§ 417.061 and 417.066, and common law.

50. Greg Weld's wrongful use of the Infringing Marks is a deliberate, intentional and willful attempt to injure American Racing's business, to trade on American Racing's business reputation, and/or to confuse and deceive consumers.

51. Greg Weld's acts are greatly and irreparably damaging American Racing and will continue to damage American Racing unless enjoined by this Court. Defendants' acts are likely to cause injury to American Racing's business reputation and dilute the distinctive quality of the Weld Marks.

WHEREFORE, American Racing requests that judgment be entered in its favor and that:

A. The Court award American Racing all damages and other monetary relief available as a result of Greg Weld's and Greg Weld, Inc.'s wrongful conduct, such damages and

monetary relief including, but not limited to, actual damages, statutory damages, lost profits, Defendants' profits, treble damages and attorneys' fees as provided under the Lanham Act;

B. This Court enter injunctive relief ordering Greg Weld, the individual, and Greg Weld, Inc., and their successors, assigns, affiliates, employees, partners, and anyone acting in concert with them or at their behest or direction, to:

- (1) Cease all use of the GREG WELD, GREG WELD, INC., GREG WELD MOTORSPORTS and TEAM WELD marks and names, as well as the gregweld.com and gregweldinc.com domain names, and any other trade name, trademark, logo, domain name, designation or design mark that contains WELD or is otherwise confusingly similar to the WELD Marks;
- (2) Refrain from doing any other act or thing likely to induce the belief that Greg Weld's and/or Greg Weld, Inc.'s business, products, services or commercial activities or are in any way legitimately connected with or sponsored or approved by American Racing;
- (3) Deliver up for destruction all labels, signs, brochures, prints, promotional materials, advertisements, packaging, manuals, wheel inscriptions and any and all other material of an infringing or unfair or deceptive nature in Greg Weld's and/or Greg Weld, Inc.'s possession or control, as well as all plates and other means of making the same;
- (4) Disable all websites or email accounts owned, operated or controlled by Greg Weld, Greg Weld, Inc., or any of their affiliates, partners or employees that contain the Infringing Marks and any other confusingly similar marks;

- (5) Remove from any website or other online marketing or promotional materials all references to the GREG WELD, GREG WELD, INC. or TEAM WELD marks, or “gregweld.com” domain name, or any other trademark, trade name, logo, domain name, designation, or design mark that contains WELD or is otherwise confusingly similar thereto;
- (6) Dissolve or rename, in accordance with subparagraphs (1) and (2) above, Greg Weld, Inc.;
- (7) Pursuant to certain controls, take corrective action by notifying all current and prior customers that neither Greg Weld nor Greg Weld, Inc. is in any way affiliated with American Racing; and
- (8) Remove all metatags for any web site owned, operated or controlled by Greg Weld, Greg Weld, Inc., or its affiliates, partners or employees that incorporate the WELD mark, the AMERICAN RACING mark, and/or any other marks or names owned or used by American Racing.

C. The Court award American Racing such other and further relief, including costs, as this Court deems just and equitable.

COUNT V

Unfair Competition and False and Misleading Advertising Under the Lanham Act

- 52. American Racing restates paragraphs 1 through 27 as if set forth herein.
- 53. Greg Weld competes with American Racing, selling various types of automotive wheels.
- 54. One of the lines of wheels sold by Greg Weld includes an inscription claiming that Greg Weld wheels are “Genuine Greg Weld Wheels.”

55. Greg Weld has recently advertised its “Genuine Greg Weld Wheels” in at least one press release, as shown below. The press release, including the image below, has been displayed on websites such as orc.off-road.com, which provide a marketplace for new and used automotive parts, including racing wheels.



56. The advertisement of the Greg Weld product in the press release, as well as this same inscription on the wheels themselves, are misleading because they essentially claim that only the Greg Weld product is genuine and that American Racing’s products using the WELD Marks are not “real” or “genuine” WELD wheels. In other words, according to Greg Weld’s advertisements and wheels, American Racing’s WELD wheels are not genuine.

57. Greg Weld’s advertisements and wheels make false and misleading statements of fact about their own wheels, as well as about American Racing’s wheels.

58. Wheels from American Racing, the owner of the real WELD wheel line, are in fact “genuine” WELD wheels, and the ones that consumers have associated with the WELD Marks and names for decades. Greg Weld’s competing startup company, which uses infringing trademarks to compete, is hardly genuine.

59. Greg Weld and Greg Weld, Inc. have been, and are likely to continue to be, unjustly enriched by their infringing conduct.

60. The aforementioned claims by Greg Weld are likely to deceive a substantial number of consumers and play a material role in influencing consumer purchasing decisions.

61. American Racing is likely to suffer injury as a result of Greg Weld's false and misleading statements and wheel inscriptions.

62. Although monetary compensation may afford American Racing some relief, much of the damages American Racing will suffer are irreparable.

63. Greg Weld's deceptive advertising was done intentionally.

64. By the actions alleged herein, Greg Weld has violated Section 43(a) of the Lanham Act by using false or misleading representations of fact in commercial advertising or promotion in connection with goods in interstate commerce. Said representations misrepresent the nature and qualities of Greg Weld's and American Racing's wheels, and American Racing is likely to be damaged by these acts.

WHEREFORE, American Racing respectfully prays for entry of judgment in its favor against Greg Weld and Greg Weld, Inc. for all relief available under Section 43 of the Lanham Act, including the following:

A. Injunctive relief precluding Greg Weld's and Greg Weld, Inc.'s further use of its false and misleading advertisements and wheels;

B. An order requiring an accounting of Greg Weld's and Greg Weld, Inc.'s profits on products on which the false and misleading statements were placed, and of products for which Greg Weld and/or Greg Weld, Inc. used false and misleading advertisements;

C. Compensatory damages including, but not limited to, an amount equal to lost profits resulting from Greg Weld's and Greg Weld, Inc.'s false and misleading advertising and unfair competition;

- D. Treble damages pursuant to Section 35(a) of the Lanham Act;
- E. Attorneys' fees and costs; and
- F. All other relief deemed by the Court to be just and proper.

COUNT VI

Tortious Interference

65. American Racing restates paragraphs 1 through 27 as if fully set forth herein.

66. American Racing has existing and valid contracts and business relationships, as well as prospective contracts and business opportunities, within the automotive field and the racing world.

67. Greg Weld, as a competing provider of automotive wheels and with full knowledge that American Racing purchased assets of certain Weld Companies, is well aware that American Racing has such contractual relationships and prospective businesses relationships.

68. Greg Weld intentionally and wrongfully interfered with those contractual relationships and prospective business relationships in numerous ways, including by improperly using the Infringing Marks to divert business from American Racing to Greg Weld, and by falsely implying that American Racing's WELD products are not genuine.

69. American Racing acquired through its purchase of certain Weld Companies in bankruptcy a supply contract with Circle Manufacturing. This contract was for certain wheels known as "Nascar wheels"—a design acquired by American Racing—and was paid in full to supply said wheels to American Racing.

70. Upon information and belief, Greg Weld was well aware of this contract by virtue of his involvement with the Weld Companies as well as his own discussions with Circle Manufacturing.

71. Upon information and belief, Greg Weld intentionally interfered with that contract and in fact has diverted the supply of the Nascar wheels intended for American Racing and instead directed Circle Manufacturing to supply Greg Weld with those same wheels.

72. Greg Weld also illegally accessed American Racing e-mails to further his anti-competitive and tortuous scheme.

73. Greg Weld had no justification for such conduct.

74. Greg Weld's actions and conduct were intentional and showed a complete indifference and conscious disregard for American Racing.

75. As a result of Greg Weld's conduct, American Racing has, at a minimum, lost \$50,000 in wheels intended for American Racing. Upon information and belief, it also stands to lose revenue from Greg Weld's wrongful acts.

WHEREFORE, American Racing prays that the Court enter its judgment in favor of American Racing and against Greg Weld and Greg Weld, Inc., and award the following relief:

- A. Actual damages in an amount exceeding \$50,000 to be proven at trial;
 - (1) Punitive damages;
 - (2) Attorneys' fees and costs; and
 - (3) Such other and further relief as the Court deems proper.

JURY DEMAND

American Racing hereby demands a jury trial on all issues so triable.

ARMSTRONG TEASDALE LLP

BY: /s/ Jeffrey H. Kass

Jeffrey H. Kass

David A. Jermann

One Metropolitan Square, Suite 2600

St. Louis, Missouri 63102-2740

2345 Grand Boulevard, Suite 200

Kansas City, Missouri 64108-2617

(314) 621-5070

(314) 612-2319 (facsimile)

ATTORNEYS FOR PLAINTIFF